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ALBRITTON

J

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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BAKER AND BOTTS

PM92/0217

BUCK, B

2001 ROSS AVENUE

EXAMINER

DALLAS TX 75201-2980

3629

ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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# Office Action Summary

Application No.

09/074,496

Applicant(s)

Albritton

Examiner

Brian H. Buck

Group Art Unit

3629

☒ Responsive to communication(s) filed on Nov. 15, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-35 is/are pending in the application.

Of the above, claim(s) 1-4, 10-23, 27, 29, and 31 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 5, 8, 9, 24, 25, 28, 30, and 32-35 is/are rejected.

☒ Claim(s) 6, 7, and 26 is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☒ The drawing(s) filed on May 8, 1998 is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2, 4, 7, 8

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

### ***Election/Restriction***

1. Applicant's election with traverse of Group II (corresponding to original claims 5-9, 24-26, 28 and 30 in Paper No. 6 is acknowledged. The traversal is on the ground(s) that no generic claims were previously identified. This is not found persuasive since (1) claim 28 said to be exemplary of a generic claim is not generic given its requirement of a frangible connection "for coupling" wherein the "coupling" function performed by the relevant connection is not pertinent to, for example, Group I identified as Figures 1-3; and (2) in regard to the mention of claims 5 and 9, Applicant has proceeded to suggest that these claims are not pertinent or generic to all of the species as identified in Paper No. 5.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 1-4, 10-23, 27, 29 and 31 are withdrawn from further consideration by the Examiner, 37 CFR 1.142(b), as being drawn to a non-elected species, the requirement having been traversed in Paper No. 6.

### ***Drawings***

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: "166", mentioned at page 22, line 30. Correction is required.

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4. The drawings are objected to because it is believed that reference sign "156", as seen in Figure 9, should properly read "256". Correction is required.
5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the (1) "hinge", as referenced in claim 33; (2) "plurality of support posts coupled to the guardrail", as in claim 34; and (3) "hinge", as referenced in claim 35 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

#### *Specification*

6. Applicant is reminded of the proper format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 250 words. It is important that the abstract not exceed 250 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

Correction is required.

7. The disclosure is objected to because: at page 24, line 19, it is believed that breakaway support post labeled as "230" should more appropriately be labeled "330".

Appropriate correction is required.

8. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: (1) with regard to claim 32, reference to first and second "flanges" being

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coupled together by a pin; (2) with regard to claim 33, reference to "extensions" of the first and second I-beams being pivotally coupled together by a hinge; and (3) with regard to claim 34, reference to first and second "flanges" being coupled together by a pin.

*Claim Objections*

9. Claim 8 is objected to because of the following informalities: the phrase "the guardrail" appears to be mentioned unnecessarily in line 3 of the claim. Appropriate correction is required.

*Claim Rejections - 35 USC § 112*

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 5-9; 24-26; 28-30 and 32-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

As to claim 5, Applicant has --

a) used the phrase "generally aligned with", the positioning of this phrase making it unclear as to whether this phrase modifies the element regarded as the "means for releasably securing" or the upper portion of the elongated body.

As to claim 8, Applicant has --

a) made it unclear as to whether an intent exists to claim either the subcombination of the breakaway support post or the combination of that post together with the guardrail. This lack of

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clarity exists since Applicant has recited the guardrail first in the functional environment of the preamble to the claim and later in the body of the claim has positively recited the guardrail as a necessary means by which other portions, e.g., the block, must be located. If an intent exists to claim only the subcombination, it is suggested that Applicant preface mention of the guardrail by the phrase "adapted to" or some equivalent, so as to remove its positive recitation. Otherwise, the combination should be clearly set forth.

As to claim 9, Applicant has --

a) provided insufficient antecedent basis for the terms "the first portion" and "the second portion" with regard to the elongated body.

As to claim 24, Applicant has --

a) utilized the phrase "structured and arranged to be located in the earth" with respect to the lower portion of the elongated body, the use of this phrase making the structural configuration of the lower portion unclear.

As to claim 25, Applicant has --

a) provided insufficient antecedent basis for the limitation "the webs", with respect to the I-beams.

As to claim 28, Applicant has --

a) at lines 7-8, recited the limitation "the guardrail", the recitation making it unclear as to whether an intent exists to claim either the subcombination of the "support post" or the combination of the "support post" and "the guardrail". This lack of clarity exists since Applicant has first recited the guardrail as part of the functional environment set forth in the preamble and later in the body of

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the claim the guardrail is positively set forth as a means by which to provide the location of the frangible connection. If the intent exists to claim only the subcombination, it is suggested that Applicant precede any positive recitation of the guardrail with the phrase "adapted to" or otherwise so as to retain the functional effect mentioned above thereby making it clear that subcombination is the subject of the claim. Otherwise, the combination should be clearly set forth.

As to claim 30, Applicant has --

a) provided insufficient antecedent basis for the terms "the upper portion" and "the lower portion" with regard to the elongated body.

As to claim 32, Applicant has --

a) at line 4, recited the limitation "the guardrail", the recitation making it unclear as to whether an intent exists to claim either the subcombination of the "support post" or the combination of the "support post" and "the guardrail". This lack of clarity exists since Applicant has first recited the guardrail as part of the functional environment set forth in the preamble and later in the body of the claim the guardrail is positively set forth. If the intent exists to claim only the subcombination, it is suggested that Applicant precede any positive recitation of the guardrail with the phrase "adapted to" or otherwise so as to retain the functional effect mentioned above thereby making it clear that subcombination is the subject of the claim. Otherwise, the combination should be clearly set forth;

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- b) at lines 4 and 6, recited the phrase “being structured and arranged” with regard to the first and second members, respectively, wherein use of this phrase makes the structural configuration of those members unclear; and,
- c) at line 12, provided insufficient antecedent basis for the limitation “the . . . second flanges”; and,
- d) at lines 13-14, provided the recitation of “a lengthened and a shortened position” making it unclear as to how such positions are to be determined given the lack of any datum by which to measure one against the other.

As to claim 33, Applicant has --

- a) at lines 5 and 7, recited the phrase “being structured and arranged” with regard to the first and second I-beam, respectively, wherein use of this phrase makes the structural configuration of those members unclear; and,
- b) at line 13, recited the use of a “hinge” whereby this recitation is unclear since the extensions of the first and second I-beams which would ordinarily comprise part of the referenced hinge have already been stated, i.e., the “hinge”, as stated, is unclear as to its components.

As to claim 34, Applicant has --

- a) at line 6, utilized the phrase “being structured and arranged” with respect to the first and second members, respectively, wherein use of this phrase makes the structural configuration of those members unclear;



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- b) at line 12, provided insufficient antecedent basis for the limitation “the . . . second flanges”; and,
- c) at line 14, provided the recitation of “a lengthened and a shortened position” making it unclear as to how such positions are to be determined given the lack of any datum by which to measure one against the other.

As to claim 35, Applicant has --

- a) at line 8, provided the recitation of “a lengthened and a shortened position” making it unclear as to how such positions are to be determined given the lack of any datum by which to measure one against the other;
- b) at line 16, stated that the I-beams are coupled by a hinge wherein it is unclear as to whether the second ends of the respective first and second I-beams comprise part of the stated “hinge” (given that the web is said to extend from the respective first end to “a location that is short of the respective second end”;
- c) at lines 18-19 and 20, provided the recitation of “a lengthened and a shortened position” and “the lengthened position”, respectively, making it unclear as to how such positions are to be determined given the lack of any datum by which to measure one against the other; and,
- d) at lines 21-22, provided insufficient antecedent basis for the limitations “the extensions” with respect to the first and second I-beams.

All claims not specifically mentioned are rejected as a matter of dependency.

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*Claim Rejections - 35 USC § 102*

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claims 5, 8-9, 28 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Gray. Gray discloses Applicant's invention in regard to the following discussion of the claims.

In regard to claim 5, a breakaway support post 22 comprising: an elongated body 42 and 43 having an upper portion 43 and a lower portion 42; a rotatable coupling assembly 41 and 58 disposed between the upper and lower portions; the upper portion having a first end; the lower portion having a second end which may be inserted into the soil adjacent a roadway; means 29 for attaching a guardrail adjacent the first end of the upper portion; and means 41 for releasably securing the upper portion with the lower portion.

As to claim 8, further comprising a block 28 disposed between the guardrail and upper portion of the elongated body and the guardrail.

In regard to claim 9 and in light of the aforementioned indefiniteness, a breakaway support post 22 comprising: an elongated body 42 and 43 having an upper portion 43 and a lower portion 42; the upper portion having a first end; the lower portion having a second end; means 29 for attaching a guardrail adjacent the first end of the upper portion; and means 41 for coupling the first portion and second portion of the elongated body.

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In regard to claim 28, a support post 22 comprising: an elongated body 42 and 43 having a first portion 43 and a second portion 42; a frangible connection 41, 58 for coupling the first and second portions; and the frangible connection oriented relative to the guardrail whereby an impact with one end of the guardrail will tend to buckle the support post and the support post will resist a rail face impact with the guardrail.

As to claim 30, wherein the frangible connection further comprises a rotatable coupling assembly 41, 58 disposed between the upper and lower portions of the elongated body.

***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 24-25, 32 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gray in view of Corey.

In regard to claims 24-25, Gray discloses a roadway guardrail system comprising: a guardrail 21; at least one support post 42 together with 43 having an upper portion 43 and a lower portion 42, the upper portion having a lower end and the lower portion having an upper end; the upper portion being coupled to the guardrail and the lower portion being structured and arranged to be located in the earth; and (as to claim 25) wherein the upper and lower portions

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each comprise an I-beam with the webs of the I-beams being oriented generally perpendicular to the guardrail (as seen in Figure 1).

Gray, although, fails to disclose the upper portion lower end being pivotally coupled to the lower portion by a hinge wherein the hinge has a pivot pin. However, Corey teaches such a hinge C having a pivot pin 1a (as in Figure 1) as a means to allow two portions to pivot relative to one another. Thus, it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to utilize the hinge of Corey with the structure as disclosed by Gray as a means to allow two portions to pivot relative to one another while adding structural integrity and dependability to the overall construction.

In regard to claim 32, Gray discloses a support post 42 and 43 comprising: a first elongated member 43 having first and second ends, with the first end of the first member being structured and arranged to couple to a guardrail; a second elongated member 42 having first and second ends, with the first end of the second member being structured and arranged to be inserted into the ground; one of the second ends having a pair of first flanges 43 extending therefrom, the first flanges being separated from each other by a gap; the other of the second ends having a second flange 44 extending therefrom; the second flange being received in the gap between the first flanges; and the first and second flanges being coupled together by a pin 41, wherein the first and second members are rotatably coupled together so as to move between a lengthened and shortened position.

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Gray, although, fails to disclose the first and second members being maintained in the lengthened position by a shearable body extending between the second flange and at least one of the first flanges. However, Corey teaches such a shearable body 11a (as in Figure 8) as a means of providing a frangible connection which, during times when force is not exerted on the connection, functions as a means of support providing added structural integrity to the overall construction. Thus, it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to utilize the structure of Corey with that of Gray as a means of providing a frangible connection which, during times when force is not exerted on the connection, functions as a means of support providing added structural integrity to the overall construction.

In regard to claim 34, Gray discloses a roadway guardrail system comprising: a guardrail 21; a plurality of support posts coupled to the guardrail (as in Figure 1); at least one of the support posts comprising first and second elongated members 43, 42, with the first member having first and second ends, the first end of the first member being coupled to the guardrail, the first end of the second member being structured and arranged to be inserted into the ground adjacent a roadway; one of the second ends having a pair of first flanges 45 extending therefrom, the first flanges being separated from each other by a gap; the other of the second ends having a second flange 49 extending therefrom; the second flange being received in the gap between the first flanges (as in Fig. 6); and the first and second flanges being coupled together by a pin 41, the pin being generally transverse to the guardrail, wherein the first and second members are rotatably coupled together so as to move between a lengthened position and a shortened position.

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Gray, although, fails to disclose the first and second members being maintained in the lengthened position by a shearable body extending between the second flange and at least one of the first flanges. However, However, Corey teaches such a shearable body 11a (as in Figure 8) as a means of providing a frangible connection which, during times when force is not exerted on the connection, functions as a means of support providing added structural integrity to the overall construction. Thus, it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to utilize the structure of Corey with that of Gray as a means of providing a frangible connection which, during times when force is not exerted on the connection, functions as a means of support providing added structural integrity to the overall construction.

*Allowable Subject Matter*

16. Claims 6-7 and 26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

17. Claims 33 and 35 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2<sup>nd</sup> paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

*Conclusion*

18. The prior art made of record and not relied upon; which is considered pertinent to Applicant's disclosure includes: King, Kendall et al., Sweeney et al., Katt, Ballingall et al.,

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Persicke, Cicinnati, Gray ('965), Graham, Miller-Masury, Watson, Lavender et al., Nehls, Baumann, and Chisholm.

19. Any inquiry concerning this communication should be directed to Brian H. Buck at telephone number (703) 305-0845 during the hours of 9 a.m. to 5 p.m., e.s.t., Monday through Thursday.

Any inquiry of a general nature which specifically relates to the status of this application may be directed to the group receptionist whose telephone number is (703) 308-1113. The facsimile numbers for this group (Official Papers) are as follows: (703) 305-7687.

BHB   
February 11, 2000.



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